

McAree, Angela

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**REMARKS****Restriction Election**

Examiner has required restriction between Invention I, reading on claims 1-13, Invention II, reading on claim 14-20, and Invention III, reading on claims 21-24. Examiner has stated that the apparatus of Invention I can be utilized for a materially different process than the methods of Inventions II and III, namely for measuring the distance between two points.

**Applicant's Response**

Applicant elects to prosecute Invention I, Claims 1-13. There is no change to inventorship. Applicant further traverses Examiner's restriction for the reasons below.

Examiner has cited class 33, subclass 403 (measuring instrument: straight edge) as applicable to the article of Invention I; class 33, subclass 194 (measuring instrument: door and window gauge) as applicable to the method of Invention II; and, class 33, subclass 562 (template gauge) as applicable to the method of Invention III. Applicant respectfully submits that there is no burden to Examiner in searching within the single class 33. In particular, Applicant notes that Trevino (U.S. Patent No. 5,357,683), principally cited by Examiner against the article of Invention I, is actually in the same group of subclasses under heading "gauge" as Inventions II and III.

Accordingly, Applicant respectfully submits that Examiner has not identified any burden as is required by MPEP § 803, wherein an application may only properly be required to be restricted to one of two or more claimed inventions if they are able to support separate patents and they are either independent ( MPEP § 806.04 - § 806.04(i)) or distinct ( MPEP § 806.05 - § 806.05(i)). **"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."** MPEP § 803. Here all three Inventions are in the same class 33, the principal art cited is against Invention I is actually from the same subclass heading ("gauge") as Inventions II and III, and thus, there should not be a serious burden on the Examiner.

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**Amendment to the Specification**

Applicant has amended the paragraph beginning at page 8, line 4 to more particularly define first surface 24 of base 20 as planar, and nubs 50 as extending perpendicularly from first surface 24, both being disclosed in the original drawing Figures 1A-1D. No new matter has been added.

Applicant has amended the paragraph beginning at page 9, line 2 to more particularly define rotating ruler 40 as comprising a 'U'-shape to receive nubs, or projections therewithin as is disclosed in the original drawing Figures 1B-1D. No new matter has been added.

**102(b) Rejections**

Examiner has rejected claims 1-3, 5, 7-11 and 13 under 35 U.S.C. 102(b) as being anticipated by Trevino (U.S. Patent No. 5,357,683).

Examiner has rejected claims 1, 2 and 4 under 35 U.S.C. 102(b) as being anticipated by Valentine (U.S. Patent No. 1,559,386).

Examiner has rejected claims 1 and 7 under 35 U.S.C. 102(b) as being anticipated by Byrne (U.S. Patent No. 550,904).

Applicant respectfully traverses.

**Applicant's Response**

Applicant has amended claim 1 to include the limitation of projections disposed on the planar surface of the base, as shown in FIGS. 1B-1D, and as described in the specification paragraph beginning at page 9, line 2, as amended. Applicant has further amended claim 1 to include that the projections extend perpendicular from the plane of the base, as shown in FIGS. 1A-2 and in the specification at page 8, lines 12-14, as amended. No such perpendicularly-disposed projections are disclosed in the prior art cited by Examiner, and Applicant respectfully submits that claim 1 is now in condition for allowance.

Regarding Examiner's rejection of claim 5, the caps 18 of Trevino '683 do not comprise a mounting means, and in fact, only "helps to keep the tool from slipping while it is being positioned for locating of marking an outlet". See column 3, lines 37-39.

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Accordingly, Applicant respectfully submits that Examiner's rejection of claim 5 is improper.

Regarding Examiner's rejection of claim 7, reference numeral 16 of Trevino '683 identifies a hinge member connecting two components (see column 3, lines 44-48), not a fixed base portion attached to a single component. Said hinge member is structurally and functionally different from Applicant's invention. Byrne '904 discloses annular disk 2 composed of two separated annular plates 3,4 (see page 1, lines 24-26), not a solid semicircular disc as in Applicant's invention. Accordingly, Applicant respectfully submits that Examiner's rejection of claim 7 is improper.

Applicant has amended claim 8, to clearly point out that the projections are disposed on the planar surface of the base proximate the periphery of the base, as shown in the Drawing Figures 1A-2 and as described in the specification at page X, line Y, as amended.

Regarding Examiner's rejection of claim 8, reference numeral 22 of Trevino '683 identifies "indentations" not projections. See column 3, line 55. Examiner characterizes the indentations of Trevino '683 as projections, which they clearly are not. Even if, *arguendo*, these indentations could constitute projections, they are carried, not on the upper surface of hinge member 22, but on the periphery of hinge member 22. Accordingly, Applicant respectfully submits that Examiner's rejection is improper.

Applicant has amended claim 11, to clearly identify the first surface as a planar surface as shown in the Drawing Figures 1A-1D and as described in the specification at page X, line Y, as amended.

Regarding Examiner's rejection of claim 11, reference numeral 24 of Trevino '683 defines a "catch" comprising a spring loaded ball bearing within a bore. See column 3, lines 57-59. It cannot receive a projection, it can only insert into an indentation, as described by reference numeral 22. Thus, not only is the combination of Trevino '683 more complicated than Applicant's device, in that it requires more components, but also the locking surface is not dimensioned to receive one of said plurality of projections, and further, even if indentations 22 could comprise projections, they would not be carried on the surface of the base, rather being carried on the periphery of the hinge member.

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### **103(a) Rejections**

Examiner has rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over Trevino (U.S. Patent No. 5,357,683) in view of Acopulos (U.S. Patent No. 5,713,135).

Examiner has rejected claims 8 and 12 under 35 U.S.C. 103(a) as being unpatentable over Byrne (U.S. Patent No. 550,904) in view of Novak (U.S. Patent No. 845,009).

Applicant respectfully traverses.

### **Applicant's Response**

Regarding Examiner's rejection of claim 6, Applicant respectfully points out that Examiner has combined pins 64 of Acopulos '135 with caps 18 of Trevino '683, to reject Applicant's claim. Applicant's device does not require the caps 18 of Trevino '683, and thus, because Examiner's rejection requires additional components not required by Applicant's invention, Applicant respectfully submits that Examiner's rejection of claim 6 is improper.

Regarding Examiner's rejection of claim 8, Applicant's projections are carried on the upper surface of Applicant's device proximate the periphery of a semicircular portion of Applicant's device. See FIGS. 1A-2 and specification page 8, lines 12-16, as amended. Novak '009 carries what Examiner has identified as "receiving areas" on the periphery of the semicircular portion of Novak '009's device. Examiner characterizes the receiving areas as projections, which are not identified by any separate reference numeral. To the extent that these could constitute projections, they are carried, not on the upper surface, but on the periphery of Novak '009's device. Accordingly, Applicant respectfully submits that Examiner's rejection is improper.

Regarding Examiner's rejection of claim 12, Novak '009 identifies recesses or receiving portions via reference numeral 11 (see page 2, lines 5-6). Novak '009 does not identify a plurality of projections and further does not assign reference numeral 11 to any projections. It is evident from the figures in Novak '009 that the recesses or receiving portions identified by reference numeral 11 are narrower than the width of any of elements 12, 13 and 15 of Novak '009, which collectively make up what is similar to the arm of Applicant's invention. Accordingly, Applicant clearly distinguishes over Novak '009.

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wherein each of Applicant's receiving areas are at least the width of said at least one moveable arm and Applicant respectfully submits that Examiner's rejection of claim 12 is improper.

Miscellaneous

Applicant has amended withdrawn claim 20.

Applicant has cancelled claims 21-24.

Applicant has added new independent claim 25 as supported in the specification paragraphs beginning at page 8, line 4 and page 9, line 2, as amended. In view of the cancellation of independent claim 21, no new fee should be required for new independent claim 25.

**CONCLUSION**

The above election and amendments are to form, and, thus, no new matter was added. Given Applicants' amendments, claim cancellations, and withdrawal of claims herein, Applicants' application should now be allowable. Notwithstanding, Applicant respectfully believes that Examiner's rejection of claims 1-13, and restriction of claims 14-24 is herein traversed. Applicant further submits that Examiner's rejection of claims depending from claim 1 is now moot, and that claims 1-20 and 25 are now allowable.

Applicant respectfully requests that the application proceed to issuance in view of the amendments to the claims. Applicant reserves the right to file divisional applications and/or continuation-in-part applications during the pendency of this application and may pursue further examination of the rejected original and withdrawn claims, and Applicant specifically reserves the right to pursue the un-amended original and/or cancelled claims under such a related application.

Applicant respectfully believes that Applicant's application is now in condition for allowance. Otherwise, should the Examiner have any questions regarding this submission, he is invited to contact the undersigned counsel at the address or telephone number below.

{Signature follows on next page}

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Respectfully submitted, this 23<sup>rd</sup> day of May, 2005,



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